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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,482	12/21/2001	Daniella Giacchetti	05725.1011-00	4566

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EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3628	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/024,482	GIACCHETTI, DANIELLA	
	Examiner	Art Unit	
	Igor N. Borissov	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Amendment received on 09/20/2006 is acknowledged and entered. Claims 1, 3 and 18 have been amended. New claims 20 and 21 have been added. Claims 1-21 are currently pending in the application.

Claim Objections and Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to theconditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors":

(a) "Useful" - The Supreme Court in Diamond v. Diehr requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" - Applying In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In Warmerdam the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than presenting information to a consumer. The method step of: "enabling selection of at least one of the displayed templates" does not require the actual selection step to be performed, and, as such, does not guarantee the displaying step, and can be understood as merely having an idea about how to arrange the selection of said displayed templates. Therefore, the method, as a whole, does not produce a tangiable, useful and repeatable result. Same reasoning is applied to the step of: "facilitating display", which does not require the displaying step to be performed.

Accordingly, the claimed invention does not appear to provide tangible, concrete and/or useful result and is, therefore, deemed to be non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 and 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Orpaz et al. (US 6,937,755).

Orpaz et al. (Orpaz) teaches a computer-implemented method, computer-readable medium and system for simulating an appearance of make-up and fashion accessories on an human image, said system including a processor and a wide area network, said method comprising:

Independent Claims

Claims 1, 16, 17 and 18.

Facilitating of displaying a plurality of templates, wherein at least some of the templates are representative of a portion of a face having a simulation of use of a beauty product (Figs. 12-18; C. 6, L. 20-41);

enabling selection of at least one of the displayed templates (C. 6, L. 61-65);

facilitating display, on the display device, of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein simulation of the displayed facial portion corresponds to a simulation of the at least one selected template (C. 6, L. 66 - C. 7, L. 13).

Dependent Claims

Claim 2. Said method, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion along with a simulation of a differing beauty product (C. 2, L. 63-66).

Claim 3. Said method, wherein the beauty product comprises make-up, and wherein each template in the group of templates has a simulation of a differing make-up (C. 2, L. 63-66).

Claim 4. Said method, wherein each template in the group has a simulation of make-up with at least one of a differing color, a differing texture, a differing brand, and a differing formulation (C. 3, L. 10-12, 47, 53-55; C. 4, L. 5-11).

Claim 5. Said method, wherein the plurality of templates Comprise a group of templates each having a different shaped facial portion (Figs. 12-18).

Claim 6. Said method, wherein the facial portion is chosen from lips, eyes, cheeks, and eyebrows (Figs. 12-18).

Claim 7. Said method, wherein the beauty product comprises make-up (C. 1, L. 50-54; C. 5, L. 1-5).

Claim 8. Said method, wherein the simulated facial image is one of two-dimensional image and a three-dimensional image (Fig. 6).

Claim 9. Said method, wherein the simulated facial image is displayed on a simulated likeliness of at least a portion of a human (C. 2, L. 63-66).

Claim 10. Said method, further comprising enabling selection of at least one article of clothing, wherein the selected article of clothing is displayed on the simulated likeness (C. 10, L. 9-17).

Claim 11. Said method, wherein at least one of facilitating display of a plurality of templates, enabling selection of at least one of the displayed templates, and facilitating display of a simulated facial image comprises providing access to software (C. 6, L. 61-65; C. 3, L. 21-26).

Claim 13. Said method, comprising enabling application of coloration to the simulated facial image to simulate at least one of actual skin tone and actual hair color (C. 10, L. 47-49).

Claim 14. Said method, wherein the beauty product comprises a cosmetic product chosen from mascaras, eye shadows, eye liners, foundations, concealers, blushers, lip make-ups, lip sticks, lip glosses, and hair colorings (C. 10, L. 47-49).

Claim 15. Said method, wherein further comprising enabling storage of the simulated facial image for selective recall by an individual (C. 4, L. 29-50).

Claim 19. Said method, wherein the beauty product comprises make-up (C. 5, L.1-5).

Claim 20. Said method, further comprising displaying the plurality of templates, wherein enabling selection comprises selecting at least one of the displayed templates, and wherein facilitating display of the simulated facial image comprises displaying the simulated facial image (Figs. 12-18; C. 6, L. 66 - C. 7, L. 13).

Claim 21. Said method, wherein the plurality of templates comprise a group of templates each having substantially the same shaped facial portion (lips) along with a simulation of a differing beauty product (liner products and lipstick products) (Figs. 12 and 13; C. 6, L. 30-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orpaz et al. in view of Lambertsen (US 2002/0024528).

Dependent Claim

Claim 12. Orpaz teaches all the limitations of Claim 12, except specifically teaching selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows.

Lambertsen teaches a virtual makeover system and method, wherein users can apply beauty products to an image of a human, and wherein various portion of a facial image including a head, eyes, nose, lips, ears, and eye brows are provided with a default shape, said default shape can be changed (reshaped) by the user (Fig. 4; [0010]; [0011]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Orpaz to include selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eye brows, as disclosed in Lambertsen, because it would advantageously allow users to create a new "look" not only for themselves, but for other user as well, thereby potentially increase revenue (Lambertsen; [0011]).

Response to Arguments

Applicant's arguments filed 09/20/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the recited method steps provide "useful, tangible and concrete results", the examiner maintains that the step "enabling *selection of at least one of the displayed templates*" can be understood as merely having an idea about how to arrange the selection of said displayed templates, and does not require the actual "selecting" action, and, as such, does not guarantee the displaying step, and/or repeatability of the result. Therefore, the method, as a whole, does not produce a concrete, useful and tangible result. Same reasoning is applied to the step of: "facilitating display", which does not require the displaying step to be performed.

In response to applicant's argument that Orpaz does not disclose facilitating display of a plurality of templates, it is noted that Orpaz explicitly teaches said features (Figs. 12-15).

In response to applicant's argument that Orpaz does not disclose enabling selection of the at least one of the displayed template, it is noted that Orpaz specifically teaches said feature (C. 6, L. 61-65).

In response to applicant's argument that Orpaz does not disclose a viewing display, it is noted that Orpaz explicitly teaches *a graphic monitor 22* (C. 2, L. 42).

In response to applicant's argument that Lambertsen does not disclose facilitating display of a plurality of templates; enabling selection of the at least one of the displayed template; and a viewing display, it is noted that Orpaz was applied for these features.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or eadier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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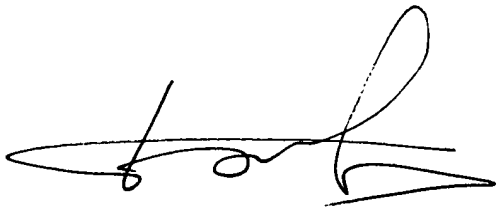

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